

ESTTA Tracking number: **ESTTA541339**Filing date: **06/03/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Cadbury UK Limited		
Entity	Corporation	Citizenship	United Kingdom
Address	PO Box 12 Bournville Lane Bournville Birmingham, B30 2LU UNITED KINGDOM		

Attorney information	Robert A. Becker Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES rbecker@frosszelnick.com Phone:212-813-5900
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Registration Subject to Cancellation

Registration No	4206026	Registration date	09/11/2012
Registrant	Meenaxi Enterprise, Inc. 2500B Hamilton Boulevard South Plainfield, NJ 07080 UNITED STATES		

Goods/Services Subject to Cancellation

Class 029. First Use: 2008/01/01 First Use In Commerce: 2008/01/01 All goods and services in the class are cancelled, namely: [Bases for making milk shakes;] Beverages consisting principally of milk; Beverages having a milk base; Chocolate milk; Dried milk powder; Milk beverages containing fruits; Milk drinks containing fruits; Milk powder; Milk shakes; Milk-based beverages with chocolate; Milk-based beverages with high milk content; Milk-based energy drinks; Nut-based milk; Powdered milk; Protein milk; Strawberry milk; Vanilla milk
Class 030. First Use: 2008/01/01 First Use In Commerce: 2008/01/01 All goods and services in the class are cancelled, namely: Chocolate powder; Chocolate-based beverages; Chocolate-based beverages with milk; Cocoa; Cocoa beverages with milk; Cocoa powder; Cocoa-based beverages; Cocoa-based condiments and seasonings for food and drink; Hot chocolate

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant is not the owner of the applied-for mark so registration would violate Trademark Act Section 1(a).

Attachments	F1238005.PDF(368186 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Robert Becker/
Name	Robert A. Becker
Date	06/03/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Reg. No. 4,206,026
Mark: BOURNVITA

CADBURY UK LIMITED,

Petitioner,

v.

MEENAXI ENTERPRISE, INC.,

Registrant.

Cancellation No. _____

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BOX TTAB – FEE

PETITION FOR CANCELLATION

Petitioner, Cadbury UK Limited, a United Kingdom corporation with an address at PO Box 12, Bournville Lane, Bournville, Birmingham, B30 2LU, United Kingdom, believes that it will be damaged by the continued registration of the mark BOURNVITA shown in Reg. No. 4,206,026, registered on September 11, 2012, for goods in International Classes 29 and 30 (as fully identified below), and therefore petitions to cancel the same. As grounds for this cancellation, Petitioner, through its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

A. Petitioner's BOURNVITA Mark

1. Petitioner and its related entities manufacture and produce a wide variety of well-known food and beverage products that are sold around the world. Among these products is BOURNVITA brand drink mixes.

2. BOURNVITA branded malt drink mixes were launched in India in 1948. The brand is among the oldest brands in the malt food category and has been a leader in that category for over 60 years.

3. Only Petitioner and those entities that are authorized by Petitioner may use the BOURNVITA mark in the United States.

4. Long prior to any date on which Registrant can rely, Petitioner's BOURNVITA mark and product had become well known among consumers not only in the United States but also among consumers who are from or have family or cultural ties to India, Nigeria, and other African countries.

5. The BOURNVITA mark is wholly arbitrary as it relates to Petitioner's goods. The term BOURN in Petitioner's BOURNVITA mark was taken from Bournville Lane, the street on which Petitioner is located, and Bournville, the town in which Petitioner is located.

6. As a result of the use of the BOURNVITA mark in the United States by Petitioner and those who have been authorized by Petitioner to use the BOURNVITA mark, Petitioner has acquired common law rights in the BOURNVITA mark, and consumers associate the BOURNVITA mark and the products marketed under that mark exclusively with Petitioner. The BOURNVITA mark represents substantial goodwill of Petitioner that merits protection.

B. Registrant and its Registration

7. Registrant is a New Jersey corporation with a stated address of 2500B Hamilton Boulevard, South Plainfield, NJ 07080.

8. On information and belief, Registrant is engaged in importing well-known products from India and other countries and selling them to consumers in the United States. Among the products that Registrant imports and advertises on its website is Petitioner's very BOURNVITA drink mix. In fact, the only BOURNVITA branded product advertised on Registrant's website is Petitioner's product.

9. There is no agreement of any kind between Petitioner and Registrant that would allow Registrant to use the BOURNVITA mark or to claim ownership of the mark.

10. As a matter of law, Registrant's unauthorized distribution of BOURNVITA branded products of Petitioner does not give Registrant any basis to claim ownership rights in or to the BOURNVITA mark.

11. Registrant has never been authorized by Petitioner to claim rights or ownership of the BOURNVITA mark or to sell BOURNVITA branded products to the public, and Registrant is not and has never been an authorized distributor of BOURNVITA branded goods. To the extent that Registrant is selling Petitioner's product to the public it is without Petitioner's permission or the permission of Petitioner's authorized distributors and in selling the product Registrant is falsely holding itself out as an authorized distributor of and/or user of the BOURNVITA mark of Petitioner or is otherwise misrepresenting its relationship with Petitioner.

12. Registrant is the owner of Reg. No. 4,206,026 (the "Registration"), which issued September 11, 2012, for the mark BOURNVITA (the "Mark"). The Registration covers "Beverages consisting principally of milk; Beverages having a milk base; Chocolate milk; Dried milk powder; Milk beverages containing fruits; Milk drinks containing fruits; Milk powder; Milk shakes; Milk-based beverages with chocolate; Milk-based beverages with high milk content; Milk-based energy drinks; Nut-based milk; Powdered milk; Protein milk; Strawberry milk; Vanilla milk" in Class 29 and "Chocolate powder; Chocolate-based beverages; Chocolate-based beverages with milk; Cocoa; Cocoa beverages with milk; Cocoa powder; Cocoa-based beverages; Cocoa-based condiments and seasonings for food and drink; Hot chocolate" in Class 30. Registrant claims a date of first use of January 1, 2008.

13. The application that matured into the Registration was application Ser. No. 85/540,380 (the "Application"). On information and belief, the alleged first use in commerce date of January 1, 2008 in the Application was based on a sale of products manufactured by Petitioner and distributed by Registrant in the United States without Petitioner's authorization.

14. On information and belief, any use made by Registrant of the Mark was solely in connection with distributing Petitioner's own branded product. Such use does not create ownership rights in a trademark. T.M.E.P. §1201.06(a) (a distributing agent of goods of a manufacturer "does not acquire a right of ownership in the manufacturer's or producer's mark merely because it moves the goods in trade").

15. Registrant has never received any written consent from Petitioner to register the Mark or to claim ownership of Petitioner's mark.

16. As part of the Application, Registrant's representative, under Registrant's authorization, signed a declaration stating that "he...believes the applicant to be the owner of

the trademark...sought to be registered...; to the best of his...knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive....” (This statement is hereafter referred to as the “Declaration Statement.”)

17. As of the date that Registrant filed the Application and as of the date that Registrant executed the signed declaration, Registrant was at most distributing Petitioner’s BOURNVITA beverage mixes and was aware that the BOURNVITA mark used for such goods was associated exclusively with Petitioner and with Petitioner’s goods.

18. Registrant’s registration and its assertion of exclusive rights in what it knows to be Petitioner’s very mark is inconsistent with Petitioner’s prior use of and rights in and to the BOURNVITA mark. The continued registration of the Mark will harm Petitioner.

COUNT ONE
REGISTRANT IS NOT THE OWNER OF THE REGISTERED MARK

19. Petitioner repeats and realleges the allegations set forth in paragraphs 1 through 18 above as if fully set forth herein.

20. Registrant is not, and was not at the time of filing the Application, the rightful owner of the Mark, and thus registration of the Mark by Registrant violated Section 1(a) of the Lanham Act, 15 U.S.C. § 1051.

21. Registrant’s sole claim is as an unauthorized distributor of Petitioner’s branded product. Registrant cannot claim or assert any rights in the marks used in connection with the goods that it sells absent an explicit agreement to the contrary which does not exist.

22. There is no parent-subsidary relationship between Registrant and Petitioner.

23. Petitioner has never consented to Registrant's registration of the Mark.

24. Petitioner has never agreed or acknowledged that Registrant is the owner of the Mark in any jurisdiction.

25. Petitioner has never assigned Petitioner's rights in the Mark in any jurisdiction to Registrant.

26. The continued registration of the Mark by Registrant would prevent Petitioner, which is the rightful owner of that Mark, from registering that Mark itself. Such continued registration also casts a cloud over Petitioner's ownership of and right to use that Mark, since such registration gives Registrant a rebuttable presumption of an exclusive right to use the Mark. Thus, the continued registration of the Mark to Registrant damages Petitioner.

COUNT TWO
FRAUD ON THE PTO

27. Petitioner repeats and realleges the allegations set forth in paragraphs 1 through 26 above as if fully set forth herein.

28. When Registrant filed the Application, Registrant was not the owner of the Mark, and Petitioner was the owner of the Mark.

29. When Registrant filed the Application, Registrant, who had long been selling BOURNVITA branded products of Petitioner, was fully aware that BOURNVITA was a brand of Petitioner.

30. Thus, when Registrant filed the Application Registrant knew that it was not the owner of the Mark.

31. When Registrant filed the Application, Registrant could not and on information and belief did not believe that no other person, firm, corporation, or association had the right to use

the Mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

32. On information and belief, when Registrant filed the Application, Registrant knew that the Declaration Statement was false.

33. In executing and submitting the declaration in support of the Application, Registrant knowingly made a false, material misrepresentations of fact when it filed the Application, with the intent to defraud the United States Patent and Trademark Office, by claiming that it was the owner of the Mark and that no other person, firm, corporation, or association had the right to use that Mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, when in fact Registrant knew that Petitioner, and not Registrant, was the owner of the Mark, and that Petitioner had such right to use the Mark, and by obtaining a registration based on such fraudulent claims.

34. Registrant made the false statements in the Declaration Statement for the sole purpose of obtaining rights in the BOURNVITA mark to which it was not otherwise entitled.

35. Registrant's conduct constitutes fraud on the United States Patent and Trademark Office.

36. By virtue of Registrant's fraudulent statement, registration of the Mark to Registrant must be cancelled. The continued registration of the Mark by Registrant would prevent Petitioner, which is the rightful owner of the BOURNVITA mark, from registering that Mark itself. Such registration also casts a cloud over Petitioner's ownership of and right to use

that Mark, since such registration gives Registrant a rebuttable presumption of an exclusive right to use the Mark. Thus, the continued registration of the Mark to Registrant damages Petitioner.

WHEREFORE, Petitioner respectfully requests that this Cancellation be sustained and that Reg. No. 4,206,026 for the mark BOURNVITA be cancelled.

The Trademark Trial and Appeal Board is hereby authorized to charge the cancellation filing fee of \$600 to cancel the subject registration in International Classes 29 and 30 to Petitioner's counsel's deposit Account Number 230825.

Dated: New York, New York
June 3, 2013

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

Barbara A. Solomon

Robert A. Becker

Attorneys for Petitioner
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New York, New York 10017
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CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the PETITION FOR CANCELLATION to be served by prepaid, first-class mail on this 3rd day of June, 2013, upon (a) the current owner of the mark identified in the USPTO's database as Meenaxi Enterprise, Inc., d/b/a Meenaxi Enterprise, Inc., 2500B Hamilton Blvd., South Plainfield, NJ 07080; and (b) Registrant's attorney and correspondent of record as identified in the records of the United States Patent and Trademark Office, Jungjin Lee, Esq., Lee, Lee & Associates, P.C., 2531 Jackson Avenue, Suite 234, Ann Arbor, MI 48103-3818.



Robert A. Becker